

**REMARKS**

This paper is presented in response to the Office Action. Claims 25 and 26 have been withdrawn by the Examiner as being directed to an unelected invention, and claims 27 and 28 have been added. Claims 1-5, 7-11, and 27-28 are now pending.

Reconsideration of the application is respectfully requested in view of the above amendments to the claims and the following remarks. For the Examiner's convenience and reference, Applicants' remarks are presented in the order in which the corresponding issues were raised in the Office Action.

**I. GENERAL CONSIDERATIONS**

Applicants respectfully note that the remarks herein do not constitute, nor are they intended to be, an exhaustive enumeration of the patentable distinctions between any cited references and the invention, example embodiments of which are set forth in the claims of this application. Rather, and in consideration of the fact that various factors make it impractical to enumerate all the patentable distinctions between the invention and the cited art, as well as the fact that the Applicants have broad discretion in terms of the identification and consideration of the base(s) upon which the claims distinguish over the cited references, the distinctions identified and discussed herein are presented solely by way of example. Consistent with the foregoing, the discussion herein is not intended, and should not be construed, to prejudice or foreclose contemporaneous or future consideration by the Applicants, in this case or any other, of: additional or alternative distinctions between the invention and the cited references; and/or, the merits of additional or alternative arguments.

Applicants note as well that the remarks, or a lack of remarks, set forth herein are not intended to constitute, and should not be construed as, an acquiescence, on the part of the Applicants: as to the purported teachings or prior art status of the cited references; as to the characterization of the cited references advanced by the Examiner; or as to any other assertions, allegations or characterizations made by the Examiner at any time in this case. Applicants reserve the right to challenge the purported teachings and purported prior art status of the cited references at any appropriate time.

## **II. ELECTION/RESTRICTION REQUIREMENT**

Applicants acknowledge that claims 25 and 26 stand withdrawn at present. Applicants respectfully request rejoinder of the non-elected claims upon the allowance of claim 1, from which claims 25 and 26 depend. *See MPEP 821.04.*

## **III. CLAIM REJECTIONS UNDER 35 U.S.C. §102(b)**

The Examiner rejected claims 1-3, 5, and 7-10 under 35 U.S.C. § 102(b) as being anticipated by United States Patent No. 5,668,663 to *Varaprasad et al.* ("Varaprasad") and rejected claims 1-5 and 7-11 under 35 U.S.C. § 102(b) as being anticipated by United States Patent No. 6,193,378 to Tonar et al. ("Tonar"). Applicants respectfully disagree.

Applicants respectfully note that a claim is anticipated under 35 U.S.C. § 102(b) only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Further, the identical invention must be shown in as complete detail as is contained in the claim. Finally, the elements must be arranged as required by the claim. *MPEP* § 2131.

Claim 1 recites, among other things: "...the photopolymerizable monomer bonding the electrolyte and electrochromic material to each other...." Claim 8 recites similar elements: "wherein said electrochromic material and said guest-host electrolyte form a first layer and a second layer, respectively, of said attenuation layer, and said first and second layers being bonded to each other by the photopolymerizable monomer." However, the Examiner has not even asserted, much less established, that the aforementioned claim limitations are described, either expressly or inherently, in either *Varaprasad* or *Tonar*. *See Office Action*, p. 3-5. Instead, the Examiner merely asserted that *Varaprasad* and *Tonar* are "still considered pertinent prior art because there is nothing to say that photopolymerizable element in the electrolyte would not help to increase the bonding of the electrolyte and electrochromic material layers." *See Office Action*, p. 5. *Emphasis added.*

Thus, the Examiner appears to be asserting that it is possible that the disclosed polymerizable element performs the bonding of the electrolyte and electrochromic material layers and/or that such bonding is inherently performed. In either event, the rejection of the Examiner is not well taken.

In particular, Applicants respectfully submit that inherency is not readily established. For example, as noted in MPEP § 2112, the Examiner must provide rationale or evidence showing inherency. In particular, “The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.” *In re Rijckaert*, 9 F.3d 1531, 1534 28 USPQ 2d 1955, 1957 (Fed. Cir. 1993) (emphasis in original). Moreover, the Court of Appeals for the Federal Circuit has noted that “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described by the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a thing may result from a given set of circumstances is not sufficient.’” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ 2d 1949, 1950-51 (Fed. Cir. 1999) (emphasis added).

Finally, “In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex Parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

The Examiner has not provided rationale or evidence showing inherency nor has the Examiner established that the references expressly describe the aforementioned claim limitations. Therefore, Applicants respectfully submit that the Examiner has failed to establish that the cited references anticipate either claim 1 or 8, and the rejection of claims 1 and 8, as well as the rejection of corresponding dependent claims 2, 3, 5 and 7, and 9-11 should accordingly be withdrawn.

#### **IV. NEW DEPENDENT CLAIMS 27-28**

By this paper, Applicants have added new dependent claims 27 and 28. Support for these new claims can be found in the application at, for example, paragraph [045]. Applicants submit that these new claims are allowable at least by virtue of their dependence from claims 1 and 8, respectively.

**CONCLUSION**

In view of the foregoing, Applicants respectfully submit that each of the claims 1-5 and 7-11 now pending in this application is in condition for allowance. Therefore, reconsideration of the rejections is requested and allowance of those claims is respectfully solicited. In the event that the Examiner finds any remaining impediment to a prompt allowance of this application that could be clarified in a telephonic interview, the Examiner is respectfully requested to initiate the same with the undersigned attorney.

Dated this 5<sup>th</sup> day of December, 2007.

Respectfully submitted,

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